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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/863,047	05/23/97	ITO	F 35.01208S

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NEW YORK NY 10112-3801

EXAMINER	
COLBERT, E	
ART UNIT	PAPER NUMBER

2771

DATE MAILED:

08/06/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.  
**08/863,047**

Applicant(s)  
**Fumiaki et al**

Examiner  
**Ella Colbert**

Group Art Unit  
**2771**



☒ Responsive to communication(s) filed on May 23, 1997

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire Three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-14 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 4, 10, and 13 is/are allowed.

☒ Claim(s) 1, 3, 5, 6, 9, 11, 12, and 14 is/are rejected.

☒ Claim(s) 2, 7, and 8 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/863,047.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

2. Claims 1, 3 and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by Hu et al (US 5,748,188), hereafter Hu.

As to claim 1, the prior art Hu disclosed: a) a document retaining means for retaining a document and a folder (see col 7, in particular lines 60-66), b) a candidate folder determining means for determining a candidate folder (see column 4, lines 29-35), c) a notifying means for notifying the candidate folder (see column 7, in particular lines 66-67 and column 8, in particular lines 5-8) and d) a updating means for updating the feature of the folder (see column 8, in particular lines 9-31).

As to claim 3, the prior art Hu disclosed: a) candidate folders for saving the new document are determined (see column 17, in particular lines 27-43).

“Hu” discloses a document processing system in claim 1. Therefore, the claim is considered rejected for reasons analogous to those noted above for claim 9.

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***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 5, 11, 12 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hu as applied to claims 1,3 and 9 above, and further in view of Mori (US 5,418,946).

As to claim 5, the prior art Hu did not disclose: a) a retaining means for retaining folders storing a document, b) a determining means for determining a folder containing a larger amount of information or c) a notifying means for notifying the folder.

The prior art Mori disclosed: a) a retaining means for retaining folders storing a document (see column 5, in particular lines 8-12), b) a determining means for determining a folder storing

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a document, b) a determining means for determining a folder containing a larger amount of information or c) a notifying means for notifying the folder.

The prior art Mori disclosed: a) a retaining means for retaining folders storing a document (see **column 5, in particular lines 8-12**), b) a determining means for determining a folder containing a large amount of information (see **column 5, in particular lines 3-7 and lines 15-21**) and c) a notifying means for notifying the determined folder (see **Column 5, in particular lines 29-31**). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate the document processing system of Hu, as taught by Mori in order to have storage for a large amount of document information and for easier retrieval of information.

“Mori” discloses a document processing system and a computer readable storage medium in claim 5. Therefore, the claims are considered rejected for reasons analogous to those noted above for claims 11, 12 and 14.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mori as applied to claims 5, 11, 12 and 14 above, and further in view of Inoue et al (US 5,778,352), hereafter Inoue.

As to claim 6, the prior art Hu and Mori did not disclose: a) a search condition being a keyword.

The prior art Inoue disclosed: a) a search condition being a keyword (see **column 1, in particular lines 58-67 and column 2, in particular lines 1-5**). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to incorporate

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the document processing system of Hu and Mori, as taught by Inoue in order to have a means of finding a keyword in document information.

***Allowable Subject Matter***

6. Claims 2, 7 and 8 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claims 4, 10 and 13 are allowed.
8. The following is a statement of reasons for the indication of allowable subject matter:  
Applicant's independent claims 4, 10 and 13 with a document processing system and a computer readable storage medium storing programs executing the steps of judging a similarity degree between document information, a similarity order for calculating folders in accordance with the similarity judged and notifying the similarity order of the folders calculated.

***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.
10. Wang et al (5,222,234) disclosed the search result being stored in another document such as a folder.
11. Kern (5,349,170) disclosed a document processing system and storage.
12. Agrawal et al (5,724,573) disclosed candidate generation and a data structure.
13. Anand et al (5,710,900) disclosed a folder management subsystem.

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14. Anand et al (5,721,903) disclosed querying a database and retrieving data.

***INQUIRIES***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is (703)308-7064. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black, can be reached on (703)305-9707.

**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703)308-9051, (for formal communications intended for entry).

**Or:**

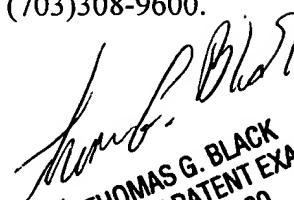
(703)305-9731 (for informal or draft communications, please label

**"PROPOSED" or "DRAFT").**

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, Virginia., Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703)308-9600.

Colbert  
July 30, 1998

  
THOMAS G. BLACK  
SUPERVISORY PATENT EXAMINER  
GROUP 2700